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10/805,694	03/22/2004	Katsushi Horihata	P1348US	8737
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CASELLA & HESPOS 274 MADISON AVENUE NEW YORK, NY 10016				
EXAMINER				
JOHNSON, GREGORY L				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/805,694

Applicant(s)

HORIHATA, KATSUSHI

Examiner

GREGORY JOHNSON

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 2, 4, 5 and 8 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2, 4, 5 and 8 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This communication is in response to the amendment filed December 16, 2008.

Status of Claims

2. Claims 1, 3, 6-7 and 9 have been canceled during prosecution. Claim 2 is as previously presented. Claim 4 is amended. Claims 5 and 8 are original. Claims 2, 4-5 and 8 are pending.

Response to Arguments

3. Applicant's arguments filed December 1, 2008 have been fully considered but they are not persuasive.

Applicants argue (pg. 9) that Nakamura (one of four, secondary references) does teach the following elements as recited in claim 4:

- (1) the electronic money information altering unit of the communications terminal subtracts a certain amount of money equivalent to the print data corresponding to the document ID from the amount of electronic money stored in the storing unit in accordance with an instruction sent from the accounting control unit and received by the sending/receiving unit to subtract the certain amount of electronic money, and
- (2) perform an electronic money settlement of collecting a print fee equivalent to the print data.

Response: In regards to element (1), Nakamura teaches a settlement process involving the use of an electronic money system comprising a settlement terminal (e.g. accounting control unit) for receiving and executing a request for settlement processing with at least one sort of electronic money, and a mobile terminal (e.g. mobile phone) including electronic money storage means for storing and holding a plurality of various sorts of the electronic money, in which the mobile terminal transmits a request for settlement processing with the electronic money in agreement with the settlement terminal. Nakamura also teaches that if the electronic money available in the mobile phone is the wrong type or the amount of currency needed is not enough, the user is able to rectify this by connecting with the electronic money exchange server to perform a currency exchange (Abstract; ¶0002, ¶0008, ¶0026, ¶0028 and ¶0039).

In regards to element (2), Aoki discloses that the MFP printer **receives the electronic money sent by the cellular phone**, and transfers some of the received electronic money to the contents provider via a network (i.e. electronic money is collected and the payment for print data is settled (¶0136-0137).

The combination of Aoki, Rosen, Kawan, Nakamura and Hansmann teach the invention substantially as claimed and set forth in this Office Action. The rejections under 35 U.S.C. § 103(a) are maintained.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claims 2, 4-5 and 8 were previously rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In view of Applicant's amendment, the rejections have been withdrawn.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

8. Claims 2, 4-5 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Aoki, Pub. No. 2002/0041394 (hereinafter Aoki), in view of Rosen, Pat. No. 6,205,436 (hereinafter Rosen), Kawan, Pat. No. 6,442,532 (hereinafter Kawan),

Nakamura, Pub. No. 2004/0172359 (hereinafter Nakamura) and Hansmann et al., Pub. No. 2001/0016835 (hereinafter Hansmann).

As to claim 4, Aoki discloses a wide area network printing system which is so configured as to allow users to print out print data sent from a server by an image forming apparatus which is installed remotely away from the server but is communicatively connected therewith via the Internet, the system provided with a communications terminal storing information relating to electronic money therein, and an accounting control device which allows the users to make settlement of a print fee corresponding to the print data by data communication with the communications terminal (§0007-0014 and §0142-0144), wherein

the communications terminal includes:

- a document ID receiving unit that receives a document ID for identifying the print data from the server (§0137; via print request information);

the server includes:

- a data sending/receiving unit that communicates various data with the image forming apparatus (Abstract; §0134 and §0166);
 - a print data storing unit that stores the print data therein (§0134; via content server);
 - a document ID storing unit that stores the document ID for identifying the print data stored in the print data storing unit (§0134; via content server);
- and

- a document ID transmitting unit that transmits the document ID stored in the document ID storing unit to the communications terminal of the user (¶0134; via content server);

the image forming apparatus includes:

- an accepting unit that accepts input of the document ID by the user (¶0155-0157);
- a transmitting unit that transmits said document ID to the server (Abstract; ¶0134 and 0166);
- a receiving unit that receives the print data from the server (¶0167); and
- an outputting unit that prints out the received print data (¶0159).

Aoki does not disclose the following limitations, however Rosen teaches the elements:

the accounting control device includes:

- a deposit money storing unit that stores a certain amount of electronic money deposited in the communications terminal of the user (col. 4, lines 12-47);
- a transmitting unit that transmits a command requesting addition or subtraction of electronic money to the communications terminal (col. 4, lines 12-47); and
- an electronic money administering unit that alters the amount of electronic money stored in the deposit money storing unit in response to the

command requesting addition or subtraction of electronic money sent from the transmitting unit (col. 4, lines 12-47), and the communications terminal includes:

- a sending/receiving unit that communicates data with the accounting control device (col. 4, lines 12-47);
- a storing unit that stores a certain amount of electronic money therein (col. 4, lines 12-47),
- an electronic money information altering unit that alters the amount of electronic money stored in the storing unit therein in response to an instruction from the accounting control unit (col. 4, lines 12-47).

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Rosen within Aoki for the motivation of providing a secure electronic real-time purchase transaction between buyer and seller without third-party intervention (col. 2, lines 21-23).

Aoki also does not disclose the following element:

- a display which displays the amount of electronic money stored in the storing unit.

However, Kawan teaches that a cellular telephone with a smart card can be used as a transaction terminal. Kawan also teaches that the cellular telephone has a display and can be used to read data stored on a smart card to determine, for example, a value corresponding to an amount of funds existing in the user's account (col. 4, lines 7-64). It would have been obvious to one of ordinary skill in the art at the time of Applicant's

invention to include the aforementioned limitation as taught by Kawan within Aoki for the motivation of providing a system for performing financial transactions which utilizes wireless, portable terminals (col. 1, lines 15-20).

Aoki also does not disclose the following element:

- the electronic money information altering unit of the communications terminal subtracts a certain amount of money equivalent to the print data corresponding to the document ID from the amount of electronic money stored in the storing unit in accordance with an instruction sent from the accounting control unit and received by the sending/receiving unit to subtract the certain amount of electronic money (e.g. the local communication between user's electronic money terminal and a settlement terminal results in subtracting an amount of electronic money from the user's electronic terminal to settle the payment of goods purchased).

However, Nakamura teaches a settlement process involving the use of an electronic money system comprising a settlement terminal (e.g. accounting control unit) for receiving and executing a request for settlement processing with at least one sort of electronic money, and a mobile terminal (e.g. mobile phone) including electronic money storage means for storing and holding a plurality of various sorts of the electronic money, in which the mobile terminal transmits a request for settlement processing with the electronic money in agreement with the settlement terminal. Nakamura also teaches that if the electronic money available in the mobile phone is the wrong type or

the amount of currency needed is not enough, the user is able to rectify this by connecting with the electronic money exchange server to perform a currency exchange (Abstract; ¶¶0002, ¶¶0008, ¶¶0026, ¶¶0028 and ¶¶0039).

Both Kawan and Nakamura teach a method and system for using a cellular/mobile terminal to conduct financial transactions (e.g. payment of goods purchased). It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned mobile phone with electronic money storage area as taught by Nakamura within the combined methods of Aoki, Rosen and Kawan for the motivation to provide an electronic money system, an electronic money exchange server and a mobile terminal in which payment (for goods purchased) can be made with a variety of sorts of the electronic money (i.e. appropriate currency) via mobile terminals typified by the mobile phone (¶¶0004-0008).

Aoki discloses the following elements:

- perform an electronic money settlement of collecting a print fee equivalent to the print data (¶¶0136-0137; via the MFP printer receives the electronic money sent by the cellular phone, and transfers some of the received electronic money to the contents provider via a network);
- the data sending/receiving unit of the server is operative to communicate with the communications terminal (Abstract; ¶¶0134 and ¶¶0166), and
- to reads out the print data identified by the document ID from the print data storing unit (Abstract; ¶¶0134 and ¶¶0166).

However, Aoki does not disclose the following element:

- sends the print data to the image forming apparatus in response to receiving from the communications terminal a notification notifying that a certain amount of electronic money equivalent to the price of the print data is subtracted in the communications terminal when the document ID is received from the transmitting unit of the image forming apparatus.

Examiner's Note: The Examiner found the above limitation, as written, slightly difficult to understand. For examination purposes, the Examiner has interpreted the above limitation as follows:

- when the document ID is received by the server from the transmitting unit of the image forming apparatus,
- the server sends the print data to the image forming apparatus in response to receiving from the communications terminal a notification notifying that a certain amount of electronic money equivalent to the price of the print data is subtracted in the communications terminal (i.e. proof of payment).

Aoki discloses the 1st part of the limitation (¶0134; via the printer sends information for requesting corresponding contents data for print-out to the contents server).

Hansmann teaches the 2nd part of the limitation. Hansmann teaches a method and system for payment by means of an electronic communications device (e.g. cellular phone). Hansmann teaches that a customer sends receipt of payment to the provider (who is offering the goods and/or services) as proof of payment, and the purchased goods or service is delivered by the provider (¶0009). It would have been obvious to

one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Hansmann within Aoki for the motivation to provide a secure and commonly acceptable payment method for electronic commerce and electronically transacted purchasing (§0006).

As to claims 2 and 8, Aoki does not disclose the following limitations, however Rosen teaches the limitations:

the communications terminal includes:

- a password storing unit that stores a password used in permitting alteration of the amount of electronic money stored in the storing unit of the communications terminal (col. 11, lines 38-42);
- a password input unit that allows the user to input an arbitrary digit or digits indicative of a password by external manipulation (col. 11, lines 38-42);
- an authenticating unit that judges whether the password inputted by the password input unit coincides with the password stored in the password storing unit (col. 11, lines 38-42);
- a controlling unit that controls the electronic money information altering unit to alter the data indicative of the amount of electronic money stored in the storing unit of the communications terminal in response to the instruction sent from the accounting control unit if the authenticating unit judges that the password inputted by the password input unit coincides

with the password stored in the password storing unit (col. 4, lines 12-47);
and

- wherein the data sending/receiving unit of the server is operative to communicate various data with the communications terminal or the accounting control device, and to send the print data to the image forming apparatus in response to receiving, from the communications terminal or from the accounting control device, information relating to the electronic money stored in the storing unit of the communications terminal, and based on a judgment that the price of the print data whose transmission has been requested from the communications terminal does not exceed the amount of electronic money stored in the storing unit (col. 21, lines 50-53; via checking if the money module (i.e. the communications terminal has sufficient funds to cover payment.

It would have been obvious to one of ordinary skill in the art at the time of Applicant's invention to include the aforementioned limitation as taught by Rosen within Aoki for the motivation to provide a secure transaction environment for both the buyer and the seller in which real-time purchase transactions can be performed (col.1, lines 17-24 and col.2, lines 21-23).

As to claim 5, Aoki discloses the following limitation:

- wherein the server includes thumbnail image data generating unit that generates thumbnail image data representing the print data stored in the

print data storing unit, and the server is operative to allow the data sending/receiving unit to send the document ID for identifying the print data, and the thumbnail image data to the communications terminal (¶0198-0199).

Conclusion

9. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to GREGORY JOHNSON whose telephone number is (571)272-2025. The examiner can normally be reached on Monday - Friday, 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, ALEXANDER KALINOWSKI can be reached on (571) 272-6771. The fax

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phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Alexander Kalinowski/
Supervisory Patent Examiner, Art Unit 3691

GREGORY JOHNSON
Examiner, Art Unit 3691